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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/015,328 | 12/12/2001 | Amy Qi Han | PH-7203 | 4675 |

23914 7590 05/19/2003

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,328

Examiner

Rebecca L. Anderson

Applicant(s)

HAN ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2003.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-13 are currently pending in the instant application and are objected.
Cancelled claims 14-22 were cancelled in applicant's amendment filed 21 March 2003
as Paper No. 7.

Election/Restrictions

Applicant's election of Group I, claims 1-13 and the election of the species of example 1 (page 108, Table 1) in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The election of the compound of example 1 has resulted in the following generic concept:

The compound of formula (I) wherein:

A^1 , R^3 , p , R^{9e} , R^{11} and R^{11b} are as found in claim 1,

A^2 is A^3-R^{9a} ,

W is $-B(OR^{26})(OR^{27})$,

R^1 is selected from the group: H, F; C_1-C_6 alkyl substituted with 0-3 R^{1a} ; C_2-C_6 alkenyl substituted with 0-3 R^{1a} ; C_2-C_6 alkynyl substituted with 0-3 R^{1a} ; and C_3-C_6 cycloalkyl substituted with 0-3 R^{1a} ,

R^{1a} is selected at each occurrence from the group; Cl, F, Br, I, CF_2 , CHF_2 , OH, =O, SH,

R^2 is selected from the group: H, C₁-C₄ alkyl, C₂-C₄ alkenyl, C₂-C₄ alkynyl, C₃-C₄ cycloalkyl, and C₃-C₄ cycloalkyl(C₁-C₄alkyl)-,

R^4 is selected from the group: C₁-C₆ alkyl substituted with 0-3 R^{4a} , C₂-C₆ alkenyl substituted with 0-3 R^{4a} , C₂-C₆ alkynyl substituted with 0-3 R^{4a} , C₃-C₁₀ cycloalkyl substituted with 0-4 R^{4b} , C₃-C₁₀ carbocycle substituted with 0-4 R^{4b} ; aryl substituted with 0-5 R^{4b} and aryl-C₁-C₄ alkyl substituted with 0-5 R^{4b} ,

R^{4a} is, at each occurrence, independently selected from: H, C₁-C₄ alkyl substituted with 0-3 R^{4b} , C₂-C₄ alkenyl substituted with 0-3 R^{4b} , C₂-C₄ alkynyl substituted with 0-3 R^{4b} , C₃-C₇ cycloalkyl substituted with 0-4 R^{4c} ; C₃-C₁₀ carbocycle substituted with 0-4 R^{4c} ; and aryl substituted with 0-5 R^{4c} ,

R^{4b} is, at each occurrence, independently selected from H, C₁-C₄ alkyl substituted with 0-3 R^{4c} , C₂-C₄ alkenyl substituted with 0-3 R^{4c} , C₂-C₄ alkynyl substituted with 0-3 R^{4c} ; C₃-C₆ cycloalkyl substituted with 0-4 R^{4d} and aryl substituted with 0-5 R^{4d} ,

R^{4c} is, at each occurrence, independently selected from: H, C₁-C₄ haloalkyl, C₁-C₄ haloalkoxy; C₁-C₄ alkyl substituted with 0-3 R^{4d} , C₂-C₄ alkenyl substituted with 0-3 R^{4d} , C₂-C₄ alkynyl substituted with 0-3 R^{4d} , C₃-C₆ cycloalkyl substituted with 0-4 R^{4d} and aryl substituted with 0-5 R^{4d} ,

R^{4d} is, at each occurrence, independently selected from: H, F, Cl, Br, I, -NO₂, -CN, -NCS, -CF₃, -OCF₃, =O and OH,

R^{9a} is selected from the group: H, C₁-C₆ alkyl substituted with 0-3 R^{9c} , C₂-C₆ alkenyl substituted with 0-3 R^{9c} , C₂-C₆ alkynyl substituted with 0-3 R^{9c} , C₃-C₆ cycloalkyl

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substituted with 0-3 R^{9d}; C₃-C₁₄ carbocycle substituted with 0-4 R^{9d} and aryl substituted with 0-5 R^{9d},

R^{9c} is selected from the group: C₁-C₆ alkyl substituted with 0-3 R^{9d}; C₂-C₆ alkenyl substituted with 0-3 R^{9d}; C₂-C₆ alkynyl substituted with 0-3 R^{9d}; C₃-C₆ cycloalkyl substituted with 0-3 R^{9e}; C₃-C₁₄ carbocycle substituted with 0-4 R^{9e} and aryl substituted with 0-5 R^{9e},

R^{9d} is selected at each occurrence from the group: C₁-C₄ alkyl substituted with 0-3 R^{9e}; C₁-C₄ alkoxy substituted with 0-3 R^{9e}; C₃-C₆ cycloalkyl substituted with 0-3 R^{9e} and aryl substituted with 0-5 R^{9e},

OR²⁶ and OR²⁷ taken together, form: e) a cyclic boronic ester where said cyclic boronic ester contains from 2-20 carbon atoms and

A³ is L-valine.

The remaining subject matter of claims 1-13 that is not drawn to the elected invention identified supra stands withdrawn from consideration as being drawn to a non-elected invention, 37 CFR 1.142(b). The withdrawn subject matter of 1-13 is properly restricted as it differs materially in structure and element from the elected subject matter identified supra so as to be patentably distinct there from. A reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Accordingly, restriction, as has been required, is proper.

Claim Objections

Claims 1-13 are objected to for containing non-elected subject matter. Said claims presented drawn solely to the elected subject matter identified supra would appear allowable.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

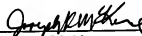
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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Joseph McKane
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